

Remarks/Arguments

Claims 5-30 are pending. Claims 5, 23, and 27 have been amended and claims 6-22, 24-26, and 28-30 have been maintained in their current form. Reconsideration of this application in light of the above amendments and the following remarks is requested.

Rejections under 35 U.S.C. § 112

Claims 27-30 have been rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 27 has been amended to clarify that which applicant regards as the invention. Applicant submits that claims 27-30 now overcome the 35 U.S.C. §112, second paragraph rejection.

Rejections under 35 U.S.C. § 102

Claims 27-30 also stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,490,632 to Vepa, et al. ("Vepa"). However, MPEP § 2131 requires that in order for a reference to anticipate a claim, each and every element of the claim must be taught. Claim 27 has been amended and now recites in part, "determining whether the first or second network access technology is active on the first or second network adapter, respectively, in a physical layer (L1) by monitoring a packet traffic and a hardware status of the first and second network adapters." This is neither taught nor suggested by Vepa. Claims 28-30 depend from and further limit claim 27, thus claims 27-30 should be allowable over Vepa. Furthermore, as explained in greater detail below, the combination of Vepa with U.S. Patent No. 6,064,649 to Johnston ("Johnston") and/or U.S. Patent No. 6,393,483 to Latif et al. ("Latif") would not obviate claims 27-30.

Rejections under 35 U.S.C. § 103

A. Combination of references fails to teach or suggest all claim limitations

As provided in MPEP § 2143, “[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Furthermore, under MPEP § 2142, “[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.” It is submitted that the Office action does not factually support a prima facie case of obviousness based on the cited references for the following reasons.

Claims 5-10

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by Vepa in view of Johnston. It is submitted that, in the present case, the examiner cannot factually support a prima facie case of obviousness because even when combined, the references do not teach the claimed subject matter.

Claim 5 has been amended and now recites in part, “detecting a change in a network access technology currently in use by the platform from the first network access technology to a second network access technology.” This is neither taught nor suggested by Vepa or Johnston, nor by their combination. For this reason, at least, a prima facie case of obviousness cannot be made and claim 5 should be allowable. Claims 6-10 depend from and further limit claim 5 and should therefore also be allowable.

Claims 11-16

Claim 11 also stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by Vepa in view of Johnston. Claim 11 recites in part, “utilizing the first network access technology for executing the active network application; and selecting the second network access technology for continuing the active network application.” The

Examiner admits that Vepa fails to show network adaptors based on different access technologies and relies on Johnston to cure this deficiency, stating that "Johnston discloses a network interface card for wireless asynchronous transfer mode networks. Johnston, Figure 3 shows wireless NIC 312 is used to connect to the wireless ATM Network 302." (Office action, p. 6). Applicant submits that Johnston fails to cure the deficiencies of Vepa, and that the combination fails to teach or suggest switching between two different network access technologies on a networked hardware platform without interrupting an active network application, as is recited in claim 11.

Since the combination of Vepa and Johnston does not teach the recited elements, a prima facie case of obviousness has not been made. For this reason, at least, claim 11 and claims 12-16, which depend from and further limit claim 11, should be allowable.

Claims 17-22

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by Vepa in view of Johnston. As before, a prima facie case of obviousness cannot be made because the combination of Vepa and Johnston fail to teach all elements of claim 17. Specifically, there is no teaching in either Vepa or Johnston of, "means for assigning a network adapter based on a first network access technology as a primary network adapter [and] means for detecting an active network adapter based on a second network access technology." For this reason, at least, claim 17 should be allowable over the cited references. Claims 18-22 depend from and further limit claim 17 and should therefore be allowable as well.

Claims 23-26

Claim 23 was rejected under 35 U.S.C. § 103(a) as being rendered obvious by Vepa. Claim 23 has been amended to recite in part, "instructions for determining an active network adapter implementing a first network access technology by monitoring packet traffic and hardware status of one or more network adapters implementing one

or more network access technologies and available on the networked hardware platform." This is neither taught nor suggested by the combination of Vepa and Johnston. Since the cited references fail to teach all of the claim elements, a prima facie case of obviousness cannot be made with respect to claim 23 and claim 23 should be allowable. Claims 24-26 depend from and further limit claim 26 and should therefore be allowable as well.

B. There is no motivation to combine the references

Furthermore, even if the combination of references cited by the Examiner taught or suggested each element of each claim (which it clearly does not, as described above), the case law is clear that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000) (emphasis added). Applicant submits that the Examiner has submitted no evidence or particular findings to support his conclusion as required.

Additionally, although Applicant strongly disagrees that the combination of references teaches or suggests each claim, even if it did, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01. "A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima

facie case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01 (emphasis original). Here, not only has the Examiner stated no objective reason to combine the references, but the references fail to even show all aspects of the claimed invention as required.

Therefore, the combination of references is improper and claims 5-30 are allowable over the cited art.

Conclusion

All rejections having been addressed, all pending claims should now be in condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

T. F. Bliss

Timothy F. Bliss
Registration No. 50,925

Dated: August 19, 2004
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 972/739-8638
File: 22171.207
r-81800.1

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 19, 2004.

Gayle Conner

Gayle Conner